

REMARKS:

Status Of Claims

Claims 1-8, 13, 14, and 30-46 were previously pending. Claim 31 has been amended. Thus, claims 1-8, 13, 14, and 30-46 are currently pending in the application with claims 1, 31, and 40 being independent.

Office Action

In the Office Action, the Examiner rejected claim 1 under 35 U.S.C. § 102(a) as being anticipated by Schoenfish, U.S. Patent No. 6,370,037 (the '037 patent). The Examiner also rejected claims 31 and 40 under 35 U.S.C. § 103(a) as being unpatentable over Schoenfish in view of Susko et al., U.S. Patent No. 5,996,866. However, Brian G. Schoenfish, the sole inventor with regard to the '037 patent, is also an inventor with regard to the present application. Therefore, Applicant traverses these grounds of rejection and submits a Declaration under 37 CFR 1.132.

The Examiner also rejected claims 1-8, 13, 31-36, 40, 41, and 43-46 under 35 U.S.C. § 103(a) as being unpatentable over Ross et al., U.S. Patent No. 5,859,628, in view of Lewis, GB 2,405,049, and Susko. The Examiner also rejected claims 14 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Ross in view of Lewis and Susko in further view of Ockerse et al., U.S. Patent No. 6,928,366. The Examiner also rejected claims 30, 37, 39, and 42 under 35 U.S.C. § 103(a) as being unpatentable over Ross in view of Lewis and Susko in further view of Yaski et al., U.S. Patent Application No. 2001/0040109.

Applicant respectfully submits that the currently pending claims distinguish the present invention from Ross, Lewis, Susko, Ockerse, Yaski, and the other prior art references of record, taken alone or in combination with each other.

Specifically, claim 1 recites “a carrying case sized and configured to **removably** fit substantially within a tray of the vehicle and configured to substantially enclose the navigational device, wherein the case is configured to conform to the tray”, emphasis added. Claim 31 now recites “a carrying case sized and configured to conform to a tray of the vehicle, wherein the tray is originally installed in the vehicle during manufacture of the vehicle, wherein the carrying case may be removed from the tray with the navigational device substantially enclosed therein”.

In rejecting these claims, the Examiner cites Ross for teaching a navigational device and a tray to house the navigational device. However, as acknowledged by the Examiner, “Ross fails to disclose a carrying case for enclosing the navigational device”. Page 6 of the Office Action. Therefore, the Examiner cites Lewis for teaching a carrying case, which is completely independent of any tray of a vehicle. So, the Examiner cites Susko. However, the Examiner simply “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Rather, the Examiner must satisfy three criteria in order to establish the requisite *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. See MPEP § 706.02(j), citing *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In presenting the suggestion or motivation to combine prior art references, the Examiner may not resort to broad and conclusory statements; as such statements are not “evidence” of anything. *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000). The suggestion to make the claimed combination must be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d at 490. If the Examiner's proposed combination renders the prior art invention unsatisfactory for its intended purpose, or changes its principal of operation, there can be no suggestion or motivation to form the combination—and thus no *prima facie* case of obviousness. See MPEP § 2143.01; *In re Gordon*, 733 F.2d at 902.

Rather than citing to specific passages in the prior art that actually show some suggestion or motivation to combine prior art references, the Examiner merely attempts to build a case that you could make his proposed combination. However, the fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125 (Fed. Cir. 1984).

In the present case, the cited references don't even seem to support the possibility of the Examiner's proposed combination and resultant modifications. For example, Ross'

cradle 104 is designed to conform to his PDA 102, and would therefore not accept any case interposed therebetween. In fact, Ross' cradle 104 includes contacts 310 and an IR link 316, with which any interposing case would surely interfere. Additionally, Susko merely teaches a drawer 16 which slides within an opening 14 of his console 12. However, Susko's drawer 16 is not removable from his opening 14.

Thus, Ross fails to teach any kind of carrying case and would not support a carrying case interposed between his PDA 102 and cradle 104. While Lewis does teach a carrying case, Lewis fails to teach "a carrying case sized and configured to removably fit substantially within a tray of the vehicle", as claimed in claim 1. Furthermore, as discussed above, Susko fails to teach "a carrying case sized and configured to **removably** fit substantially within a tray of the vehicle", emphasis added, as claimed in claim 1. Thus, no combination of Ross, Lewis, and/or Susko actually teaches each and every limitation of claim 1. Furthermore, the Examiner's proposed modification would, at the very least, change Ross's principal of operation, since the interaction between Ross' PDA 102 and cradle 104 cannot accommodate any interposing case therebetween. Therefore, there simply can be no suggestion or motivation to modify Ross in the manner suggested by the Examiner, much less properly rendering the present claims obvious.

Similarly, no combination of Ross, Lewis, and/or Susko actually teaches "a carrying case sized and configured to conform to a tray of the vehicle [that] may be removed from the tray with the navigational device substantially enclosed therein", as claimed in claim 31.

Claim 40 recites “a carrying case configured to substantially enclose the navigational device, the case being sized and configured to fit within a tray on a dashboard of the vehicle such that no securing mechanism is needed to secure the case within the tray”.

In rejecting claim 40, the Examiner mistakenly asserts that “no securing mechanism is needed to secure the portable phone (22) in the slot (18) and sunglasses (22) in the tray (16). Page 9 of the Office Action. In fact, Susko teaches arms 34 and 36 doing just that. Furthermore, claim 40 is not directed at securing a phone or sunglasses. Rather claim 40 is directed at securing “the case within the tray”. In this regard, Susko teaches guide tabs 32 which secure his drawer 16 within his slot 18. Thus, no combination of Ross, Lewis, and/or Susko actually teaches “a carrying case configured to substantially enclose the navigational device, the case being sized and configured to fit within a tray on a dashboard of the vehicle such that no securing mechanism is needed to secure the case within the tray”, as claimed in claim 40.

Finally, on page 12, the Examiner apparently takes issue with the claims use of the term “operable”. However, the Federal Circuit finds “nothing intrinsically wrong with the use of such a technique in drafting patent claims. Indeed we have even recognized in the past the practical necessity for the use of functional language. See, for example, *In re Halleck*, 57 CCPA 954, 422 F.2d 911, 164 USPQ 647 (1970).” *In re Swinehart*, 439 F.2d 210, 212 169 U.S.P.Q. 226 (1971). Similarly, the Examiner’s reliance on *Hewlett-Packard Co. v. Bausch and Lomb Inc.* is misplaced. In *Hewlett-Packard*, the Federal Circuit merely stated “[a]n invention need not *operate* differently than the prior art to be patentable”. *Hewlett-*

Packard Co. v. Bausch and Lomb Inc., 909 F.2d 1464, 1468; 15 U.S.P.Q.2D 1525 (1990) (emphasis in original). Thus, the *Hewlett-Packard* court merely said that operational differences are not required, but said nothing of actually claimed operational differences. Simply put, such functional language does not merely amount to an intended use. Rather, such functional language does further limit the scope of the claims, and therefore does convey patentable weight to the claims. Thus, the Examiner has failed to properly establish a *prima facie* case of obviousness, and therefore the present rejections cannot be sustained.

The remaining claims all depend directly or indirectly on claims 1, 31, or 40, and are therefore also allowable.

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 501-791. In view of the foregoing, a Notice of Allowance appears to be in order and such is courteously solicited.

Respectfully submitted,

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